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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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07/754,465 09/03/91 GHALY

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EXAMINER

HARRISON, J

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NEW YORK, NY 11746

| ART UNIT | PAPER NUMBER |
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3304

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DATE MAILED: 10/23/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7/28/92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-16, 18-32, 34-41 & 43-51 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 17, 33 & 42 have been cancelled.

3. ☒ Claims 1-16, 18-32, 34-41, 48 & 49 are allowed.

4. ☒ Claims 43-47, 50 and 51 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action:

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit 3304

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. The specification fails to disclose or teach that the images

displayed include a plurality of jigsaw puzzle pieces as now claimed in new claim 51. As it is improper to add new subject matter to the specification after filing, applicant is requested to direct the examiner's attention to specific lines of disclosure where this feature is supported or to delete the claim.

Claim 51 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 43-47 and 50 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 43-47 are indefinite in that it is not clear what is being claimed. The claims combine two independent claims rendering it difficult to ascertain the scope of coverage intended. Are all elements of both claims combined? How can one claim (claim 50) be both independent and further limiting? It is believed applicant intends to further define the plurality of routing means set forth in independent claims 1, 21 and 40, as well as dependent claims 48 and 49. If such is the case, each of claims 43-47 should be presented in the form (for example) "43. The game device of claim 1 wherein said plurality of routing means comprises (followed by defining language)." This clearly sets forth applicants intended scope. Care must be exercised in using consistent terminology to clearly and

distinctly define what applicant intends by the language routing means. The language of instant claim 50 as presented is vague and confusing. It is unclear what applicant is claiming by independently claiming "a routing element" as it appears to only be a set of associations, which alone, fails to completely define an operative device. The claim is excessively functional, referring to edges, squares, ports, etc., but lacks in positive recitation of these features. The examiner finds difficulty in providing helpful suggestions due to the uncertainty of applicants intentions. As allowable subject matter appears in the file, it is urged applicant consider the services of a patent prosecution professional.

Claims 1-16, 18-32, 34-41, 48 and 49 are allowable over the prior art of record.

Claims 43-47 and 50 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Because allowed claims are present in the file and applicant has made a bona fide attempt to place the case in condition for allowance, this action is not made final. Applicant is invited to telephone the examiner for an interview if the examiner may be of further assistance in preparing a response to this action.


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Any inquiry concerning this communication should be directed to Jessica Harrison at telephone number (703) 308-2217.

J. Harrison/dh
October 20, 1992

A handwritten signature in cursive script, appearing to read "Harrison", written in black ink.

JESSICA HARRISON